

REMARKS

Reconsideration of the above-identified application is respectfully requested.

Properly numbered claims are presented.

Claims 15 and 26 have been amended as thoughtfully suggested by the Examiner.

Claims 1–10 and 16–21 have been rejected as anticipated by Williams et al. Claims 1–10 and 17–21 have been canceled. Claims 22 and 23 have been incorporated into claim 16.

Claims 11–14 and 22–25 were rejected as unpatentable over Williams et al. in view of Walkden. It is respectfully submitted that there is no basis for the combination other than applicants' claims, which is improper; *In re Rouffet*, 47 USPQ2d 1453, at 1457 (Fed. Cir. 1998) [digest enclosed]. In the world of assisted mobility, ramps and lifts are as unlike as apples and oranges. For example, a ramp is not supposed to move under load. Thus, the problems facing the designers of a lift and the designers of a ramp are quite different.

Referring to FIG. 1A in the Walkden patent, note that the motion of ramp 24 is uncontrolled as the ramp is extended. This would be disastrous in a telescoping assembly for a scooter lift. It is, therefore, respectfully submitted that the Walkden patent does not suggest the claimed invention.

The claims recite at least two nested slides. The Walkden patent discloses only sliding platform 22.

Claims 15 and 26 were rejected as unpatentable over Williams et al. Claims 15 and 26 recite the operation of the lift by a single switch. This is not disclosed or suggested by the Williams et al. patent.

The Examiner suggests that such is inherent in the design of lifts. Inherency requires an element of inevitability. Control circuits for scooter lifts, so far as is known, have at least two buttons, and more typically four buttons, for controlling the lift. At least one button raises or lowers the platform and at least one button

extends or retracts the platform. To suggest that a control inherently has a single button for these functions is not appear realistic.

The *Crown Operations* decision, a portion which is enclosed as the last page of this amendment, discusses a situation where a structure is disclosed and the question was whether or not a property was inherent in the structure. In the rejection of claims 15 and 26 over the Williams et al. patent, there is no structure disclosed. It is respectfully submitted that there is clearly no inherency.

Claim 27 was rejected as unpatentable over Williams et al. in view of Ringdahl et al. It is respectfully submitted that there is no basis for the combination other than applicants' claims, which is improper; *In re Rouffet*, 47 USPQ2d 1453, at 1457 (Fed. Cir. 1998). Note all the switches in FIG. 52, for example. What is the basis, other than applicants' claims, for picking and choosing among the items disclosed in the Ringahl et al. patent? Applicants claim a single switch for controlling motion. It is respectfully submitted that the Ringdahl et al. patent teaches away from the claimed invention.

In view of the foregoing amendments and remarks, it is respectfully submitted that claims 11, 12, 13, 15, 16, 23, 24, 26, and 27 are in condition for allowance and a Notice to that effect is respectfully requested.

Respectfully submitted,



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In re Rouffet

47 USPQ2d 1453, at 1457 (Fed. Cir. 1998)

Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. §103(a). This legal construct is akin to the “reasonable person used as a reference in negligence determinations. The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. See *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ2d 1207, 1211 (Fed. Cir. 1993).

As this court has stated, “virtually all [inventions] are combinations of old elements.” *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8,12 (Fed. Cir. 1983) (“Most, if not all, inventions are combinations and mostly of old element.”). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

[2] This court has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. In this case, the Board relied upon none of these. Rather, just as it relied on the high level of skill in the art to overcome the differences between the claimed invention and the selected elements in the references, it relied upon the high level of skill in the art to provide the necessary motivation. The Board did not, however, explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Instead, the Board merely invoked the high level of skill in the field of art. If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields, the Board could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for rejection. To counter this potential weakness in the obviousness

construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.

Because the Board did not explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of Rouffet's invention to make the combination, this court infers that the examiner selected these references with the assistance of hindsight. This court forbids the use of hindsight in the selection of references that comprise the case of obviousness. See *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). Lacking a motivation to combine references, the Board did not show a proper *prima facie* case of obviousness.

47 USPQ2d 1453, at 1459 (Fed. Cir. 1998)

[3] This court does, however, discern reversible error in the Board's identification of a motivation to combine Levine and Freeburg. In determining that one of skill in the art would have had motivation to combine Levine and Freeburg, the Board noted that "[t]he level of skill in the art is very high." As noted before, this observation alone cannot supply the required suggestion to combine these references. The Board posits that the high level of skill in the art overcomes the absence of any actual suggestion that one could select part of the teachings of Levine for combination with the satellite system disclosed by Freeburg.

As noted above, the suggestion to combine requirement is a safeguard against the use of hindsight combinations to negate patentability. While the skill level is a component of the inquiry for a suggestion to combine, a lofty level of skill alone does not suffice to supply a motivation to combine. Otherwise a high level of ordinary skill in an art field would almost always preclude patentable inventions. As this court has often noted, invention itself is the process of combining prior art in a nonobvious manner, See, e.g., *Richdel*, 714 F.2d at 1579; *Environmental Designs*, 713 F.2d at 698. Therefore, even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. Cf. *Gechter v. Davidson*, 116 F.3d 1454, 43 USPQ2d 1030 (Fed. Cir. 1997) (explaining that the Board's opinion must describe the basis for its decision). In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.

The Board's naked invocation of skill in the art to supply a suggestion to combine the references cited in this case is therefore clearly erroneous. Absent any proper motivation to combine part of Levine's teachings with Freeburg's satellite system, the rejection of Rouffet's claim over these references was improper and is reversed.

Crown Operations International Ltd. v. Solutia Inc.

62 USPQ2d 1917, 1922 (Fed. Cir. 2002)

[1] Regarding alleged anticipation by the Gillery patent, on its face the Gillery patent does not disclose or discuss a two percent limitation for the reflectance contribution of the solar control film. Crown maintains that the '511 patent merely claims a preexisting property inherent in the structure disclosed in the prior art. Crown urges us to accept the proposition that if a prior art reference discloses the same structure as claimed by a patent, the resulting property, in this case, two percent solar control film reflectance, should be assumed. We decline to adopt this approach because this proposition is not in accordance with our cases on inherency. If the two percent reflectance limitation is inherently

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disclosed by the Gillery patent, it must be necessarily present and a person of ordinary skill in the art would recognize its presence. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); *Continental Can*, 948 F.2d at 1268, 20 USPQ2d at 1749. Inherency “may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.* at 1269, 20 USPQ2d at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)).

In arguing inherent disclosure of the two percent limitation in the Gillery patent, Crown bears an evidentiary burden to establish that the limitation was necessarily present. The moving party in a summary judgment motion has the burden to show “that there is an absence of evidence to support the non-moving party’s case;” the non-moving party must affirmatively demonstrate by specific factual allegations that a genuine issue of material fact exists for trial. *Celotex Corp. v. Catrett*, 477 U.S. 317, 322-23 (1986). A patent enjoys a presumption of validity, see 35 U.S.C. § 282, which can be overcome only through clear and convincing evidence, see *United States Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1563, 41 USPQ2d 1225, 1232 (Fed. Cir. 1997). Given the presumption of validity afforded the '511 patent, Crown has failed to meet its burden because it has not presented sufficient evidence to rebut the facial evidence offered by Solutia that the Gillery patent does not disclose the two percent limitation. See *Eli Lilly & Co. v. Barr Lab. Inc.*, 251 F.3d 955, 962, 58 USPQ2d 1869, 1874 (Fed. Cir. 2001) (“[A] moving party seeking to have a patent held not invalid at summary judgment must show that the nonmoving party, who bears the burden of proof at trial, failed to produce clear and convincing evidence on an essential element of a defense upon which a reasonable jury could invalidate the patent.”); *In re Robertson*, 169 F.3d at 745 (recognizing that extrinsic evidence may be required to establish inherency). Instead, Crown offers only an assumption and its own contentions.